

REMARKS

In view of the above amendments and the following remarks, reconsideration of the rejections contained in the Office Action of April 18, 2008 is respectfully requested.

In item 3 spanning pages 2 and 3 of the Office Action, the Examiner rejected claims 1, 12-19, and 32-34 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Examiner noted that previously-pending independent claim 1 recited a pre-plating treatment *while sealing an outer peripheral portion of the dry substrate*, and rinsing and electroless plating the substrate *while exposing the outer peripheral portion of the substrate*. However, the Examiner stated that the original disclosure only provides support for these processes in connection with *ejecting* pretreatment material, but not when the substrate is immersed. Thus, the Examiner is apparently taking the position that the scope of independent claim 1 is too broad, and so independent claim 1 must be narrowed so as to correspond to the combination of features that are *explicitly* taught in the original disclosure.

The Applicants do not acquiesce to the Examiner's position, and submit that there is at least *implicit* support in the original disclosure for previously-pending independent claim 1. Nonetheless, in an effort to further prosecution in this application, the Applicants have now amended independent claim 1 to address the Examiner's rejection. In particular, independent claim 1 has now been amended to clarify that the pre-plating treatment and the rinsing treatment are performed by *ejecting* a pretreatment liquid and by *ejecting* a rinsing liquid toward the surface of the substrate. As a result, it is submitted that the Examiner's formal rejections under § 112 have clearly been overcome.

The Examiner has rejected independent claim 1 and several of the dependent claims as being unpatentable over the Ferrier reference in view of the Chen reference, and further in view of either the WO '614 reference (WO 03/056614) or the JP '879 reference (Japanese Publication 2001-316879). In addition, the Examiner has rejected the remaining dependent claims as being unpatentable over the Ferrier reference in view of the Chen reference and either the WO '614 reference or the JP '879 reference, and further in view of the Stevens reference or the Yoshio reference. However, these rejections are respectfully traversed. For the reasons discussed below, it is submitted that the amended claims are clearly patentable over the prior art of record.

In the previous response filed April 3, 2008, the claims were amended to clarify the status of the substrate during the various treatments in the substrate processing method. In particular, independent claim 1 was amended to recite the following items:

- (1) *sealing* an outer peripheral portion of a substrate during a pre-plating treatment (performed, in part, to remove a metal oxide film and to impart a catalyst to the substrate);
- (2) *exposing* the outer peripheral portion of the substrate during a rinsing treatment to remove the pretreatment liquid; and
- (3) *exposing* the outer peripheral portion during an electroless plating process on the substrate.

On page 7 of the outstanding Office Action, the Examiner acknowledged that the Ferrier reference does not teach sealing of an outer peripheral portion of a substrate during pretreatment, while not sealing the peripheral portion during rinsing or electroless plating. In fact, the previously-applied Chen reference, Stevens reference, and Yoshio reference also do not teach or suggest this feature. Thus, the Examiner applied the WO '614 reference or the JP '879 reference in view of this deficiency. In particular, on page 8 of the Office Action, the Examiner explained that the teachings in either of these references would apparently allow one of ordinary skill in the art to modify the Ferrier reference in view of the Chen reference "to provide that the peripheral edge of the substrate is sealed during spray application of pretreatment liquid." However, as will be explained below, the WO '614 reference should be removed as prior art in this application, while the JP '879 reference does not provide the suggestion to modify the Ferrier reference as asserted by the Examiner.

Firstly, with respect to the WO '614 reference, it is initially noted that the WO '614 reference currently qualifies as prior art under 35 U.S.C. § 102(a) and § 102(e). In particular, the WO '614 reference was published on July 10, 2003 based on an international application filed December 26, 2002. On the other hand, the present application was filed on March 19, 2004 and claims priority to a Japanese application filed March 20, 2003. A certified copy of the priority application was submitted on September 3, 2004. In view of the above, it is clear that the priority date for the present application is earlier than the publication date of the WO '614 reference. Consequently, a verified English translation of the priority application has been submitted herewith, and the Examiner is requested to note that all of the presently-pending

claims are supported by the priority application. Therefore, because the priority date of the present application is earlier than the publication date of the WO '614 reference, it is submitted that the WO '614 reference no longer qualifies as prior art under 35 U.S.C. § 102(a) (i.e. the WO '614 reference was not published before the invention by the Applicant for patent).

As a result, the WO '614 reference now qualifies as prior art *only* under 35 U.S.C. § 102(e). Furthermore, it is noted that the subject matter of the WO '614 reference was developed "by another" (the inventorship of the WO '614 reference is different than the inventorship of the present application), *and* the subject matter of the WO '614 reference and the claimed invention of the present application were, at the time the claimed invention was made, owned by the same "person" (Ebara Corporation). Thus, under 35 U.S.C. § 103(c), it is submitted that the WO '614 reference "shall not preclude patentability" of the present application. Accordingly, the Examiner is respectfully requested to remove the WO '614 reference as prior art with respect to the present application.

The Examiner is correct that the JP '879 reference teaches sealing an outer peripheral portion of a substrate using a sealing member 23 (see Figure 1b). However, the sealing is performed *while plating* the substrate and then *washing the plated substrate* (see paragraphs [0023] and [0024]). Thus, the JP '879 reference does not teach or suggest sealing an outer peripheral portion during a *pre-plating* treatment, as required in independent claim 1 (i.e., item (1) as noted above). Furthermore, to the extent that the washing process of the JP '879 reference corresponds to the rinsing treatment of the present invention, the JP '879 reference also clearly does not teach or suggest exposing an outer peripheral portion during such a rinsing treatment, as required in independent claim 1 (i.e., item (2) as noted above). Finally, because the outer peripheral portion of the substrate is sealed with the sealing member 23 during plating as noted above, it follows that the JP '879 reference also does not teach or suggest any type of plating process performed while *exposing* the outer peripheral portion of the substrate, as required in independent claim 1 (i.e., item (3) as noted above). Thus, for these reasons alone, it is submitted that the JP '879 reference does not provide any teaching that would correct the deficiencies in the Ferrier reference and the Chen reference and thereby allow one of ordinary skill in the art to obtain the invention recited in amended independent claim 1.

Moreover, the JP '879 discloses an *electrolytic* plating process (see again paragraph [0023]) in which the outer peripheral portion is sealed during plating. Such an electrolytic

plating process requires that the outer peripheral portion of the substrate be sealed during a plating process to prevent the outer peripheral portion of the substrate from being plated. Therefore, the JP '879 reference actually *teaches away* from the limitations of amended independent claim 1 requiring that the *electroless* plating process be performed while *exposing the outer peripheral portion of the substrate*. Thus, for this additional reason, it is submitted that one of ordinary skill in the art would have absolutely no apparent reason to combine the teachings of the JP '879 reference with the Ferrier reference and/or the Chen reference so as to obtain the invention recited in amended independent claim 1. Accordingly, it is respectfully submitted that amended independent claim 1 and the claims that depend therefrom are clearly patentable over the prior art of record.

In view of the foregoing amendments and remarks, it is submitted that the present application is now in condition for allowance, and notice to that effect is hereby requested. However, if the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned at the telephone number below.

Respectfully submitted,

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ATTACHMENT

1. Verified English Translation of Japanese Priority Document No. 2003-78485